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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,453	08/03/2001	Shridhar P. Joshi	47079-00064USP1	1760

30223 7590 12/18/2003

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SUITE 2600  
CHICAGO, IL 60606

EXAMINER
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CAPRON, AARON J

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 12/18/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/922,453

Applicant(s)

JOSHI ET AL.

Examiner

Aaron J. Capron

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,17 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) 22-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,17,20,21,24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is a response to the Amendment received on November 17, 2003, in which claims 1, 17, 21 and 24-25 were amended and claims 2, 5-16, 18-19 and 26 were cancelled. Claims 1, 3-4, 17, 20-21 and 24-25 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 17, 2003 has been entered.

#### ***Election/Restrictions***

Claims 22-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group IV, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

The requirement is still deemed proper and is therefore made FINAL.

This application contains claims 22-23 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4, 17, 20-21 and 24-25 are rejected under 35 U.S.C. 102(e) as anticipated by Acres (U.S. Patent No. 6,254,483; hereafter “Acres”) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Acres in view of IGWB.

Acres discloses a gaming machine comprising monitoring a number of wager inputs from players of the gaming machine (6:44-50); and a processor for randomly selecting a plurality of outcomes in response to a wager inputs; a display for displaying the appearance for a wagering game; a memory device coupled to the processor and storing at least two data sets for producing two different appearances for the gaming machine (abstract, 1:61-65 and 3:15-20), the processor automatically selecting one of the at least two data sets primarily in response to the processor monitoring a time signal corresponding to a predetermined number of wager inputs (abstract). It is inherent that all gambling games have a theme/artwork. Most casinos use equivalent gaming machines, but have different artwork to distinguish themselves from their competitors. In the alternative, where the interpretation of appearance does not include thematic game artwork, IGWB discloses the use of reconfiguring the theme of the game machine so that the winning symbols are changed from three sevens to cherries or cabooses (IGWB pages 11, 2-4 full paragraphs) in order to change the manner in which a player perceives the gaming machine. One would be motivated to combine the references in order to change the manner in which the player

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perceives the electronic gaming machine (Acres 3:15-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the themed artwork of IGWB into the gaming machine of Acres in order to change the manner in which a player perceives the gaming machine.

Referring to claims 3-4, Acres discloses the certain value is a predetermined value such that the step of altering occurs at any predetermined frequency (3:16-20 and 6:13-50).

Referring to claim 17, Acres discloses a method of operating a gaming machine, comprising storing a plurality of data sets for producing a plurality of different types of visual motifs on a display of the gaming machine (6:4-12); displaying a first visual motif on a display, discontinuing the first visual motif and displaying a second visual motif on the display based upon use of the gaming machine (abstract and 6:13-62).

Referring to claim 20, Acres discloses the step of displaying the second one occurs after a predetermined number of plays by the players (6:40-50)

Referring to claim 21, Acres discloses the step of displaying the second one occurs after determining a favorite visual motif of a variety of visual motifs to be displayed by monitoring inputs from the players (6:14-19).

Claims 24-25 correspond in scope to a gaming machine set forth for use of the method listed in the claims above and are encompassed by use as set forth in the rejection above.

### ***Response to Arguments***

Applicant's arguments filed November 17, 2003 have been fully considered but they are not persuasive.

Applicants argue that Acres does not disclose altering the gaming machine's data set in response to the number of wager inputs. Applicants state Acres uses generic aspects of the game such as background color and card decoration and does not change the game symbols. However, Acres disclose changing the appearance of the gaming machine with respect to a predetermined number of wager inputs (abstract, 3:15-20) in order to change the manner in which the player perceives the gaming machine (3:15-16). The term "perceive" is defined as to achieve understanding of, apprehend (The American Heritage Dictionary of the English Language, Third Edition copyright 1992). Merely altering the background color and/or the card decoration will not change the manner in which a player perceives the gaming machine as asserted by Applicants in Paper #16, page 11 in the Parent Application 09/679,093 which states in part "Such background appearance items...do not constitute thematic game artwork", "For example, background color does not constitute a theme", "card decoration is, again, merely generic appearance; it does not invoke a theme...even taken together background color and card decoration do not constitute a theme as these elements...to a theme". In order to alter the appearance of the game machine, including the data sets, in a manner in which the player perceives the game, without altering the game itself (for example, from a slot game to a video poker game), the altering must involve the theme of the gaming machine. Changing the perception of the gaming machine would invoke a mental image associated with a specific subject matter related to a theme. Therefore, the claimed invention fails to preclude the invention of Acres.

### ***Conclusion***

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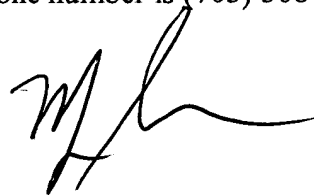
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520.

The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc

A handwritten signature in black ink, appearing to read 'M. Sager', with a stylized flourish at the end.

MARK SAGER  
PRIMARY EXAMINER